

Amendment and Response

Applicant: Daniel R. Marshall

Serial No.: 09/759,867

Filed: January 12, 2001

Docket No.: 10002307-1

Title: PORTABLE INFORMATION STORAGE MODULE FOR INFORMATION SHOPPING

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed March 31, 2003. In that Office Action, the Examiner objected to claims 1 and 15 as having insufficient antecedent basis limitations in the claims. The claim states, "an atomic resolution storage memory component" and later states in the same claim "the memory component". The Examiner also objected to claim 12 because of an informality in the word "radiofrequency"; the Examiner's suggestion to amend "radiofrequency" to "radio frequency" is noted with appreciation.

Further, the Examiner rejected claim 28 under 35 U.S.C. §112, as having insufficient antecedent basis for the limitation of "ultra-high capacity" in the claim.

The Examiner also rejected claims 1, 2, 4-7, and 9-29 under 35 U.S.C. §103(a) as being unpatentable over Gioscia et al., PCT Patent Publication No. WO 00/30117 ("the Gioscia PCT Patent") and Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Gioscia PCT Patent and Gibson. Finally, claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Gioscia PCT Patent and Gibson, and further in view of Gioscia et al., U.S. Patent No. 6,407,750 ("the Gioscia '750 Patent").

With this Amendment, claims 1-5, 9-15, 17, 18, 23, 24, and 26-29 have been amended and newly presented claims 30-37 added. It is believed that all claims are now in a condition for allowance. Notice to that effect is respectfully requested.

35 U.S.C. § 112 Rejections

On page 2 of the Office Action, the Examiner objected to claims 1 and 15 indicating that the claims state "an atomic resolution storage memory component" and later state in the same claim "the memory component". The Examiner suggested the use of the "atomic resolution storage memory component" throughout the claims. The Examiner also objected to claim 12 in that the word "radiofrequency" should be changed to "radio frequency". With this Amendment, numerous claims, including claims 1-5, 9-15, 17, 18, 23, 24, and 26-29 have been amended to correct various minor informalities. Also on page 2 of the Office Action, the Examiner rejected claim 28, stating that there was insufficient antecedent basis

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for the phrase “the ultra-high capacity storage device”. With this Amendment, claim 28 has been amended to remove this phrase.

In light of the above remarks, it is believed that all claims objected to or rejected under 35 U.S.C. §112 have been amended to correct the minor informalities. Therefore, it is respectfully requested that the rejection of claim 28 and the objection to claims 1, 12, and 15, be withdrawn.

35 U.S.C. § 103 Rejections

On page 3 of the Office Action, the Examiner rejected claims 1, 2, 4-7, and 9-29 under 35 U.S.C. §103(a) as being unpatentable over the Gioscia PCT Patent and Gibson. On pages 3-13 of the Office Action, the Examiner individually discussed each claim being rejected. In particular, on page 3 of the Office Action, the Examiner discussed independent claim 1. The Examiner stated that, with respect to claim 1, the Gioscia PCT Patent teaches a method of handling information comprising the steps of (a) storing electronically readable information into a portable storage module including a memory component; and (b) recalling selectively a portion of the information from the memory component of the portable module into an information playback device for consumption by a user.

With this Amendment, independent claim 1 has been amended such that it includes the step of “storing electronically readable information including audio and visual media into a portable storage module including an atomic resolution storage memory component.”

The Gioscia PCT Patent does not teach, show, or suggest incorporating both audio and visual media. In particular, the Gioscia PCT Patent unilaterally discusses audio files, such as audio news clips describing current events, audio books, or any other audio recordings (the Gioscia PCT Patent, page 10, lines 6-9). The Gioscia PCT Patent does not discuss visual media. In fact, the only method of playback discussed in the Gioscia PCT Patent is through use of jack or terminal 112 to which headphones (not shown) may be connected (the Gioscia PCT Patent, page 9, lines 3-5).

On page 13 of the Office Action and in reference to claim 8, the Examiner discussed the limitation of the electronic readable information being a movie. In particular, the Examiner stated that:

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“...Gioscia is silent in respect to the electronically readable information being a movie. Gioscia teaches of downloading an audio book, it would not be out of the scope of the invention to download a movie soundtrack. Therefore, one of ordinary skill in the art would be motivated to download a movie or parts thereof. Alternatively, it would have been obvious to one of ordinary skill that video players are well known in the art. Therefore, one of ordinary skill in the art would be motivated to download a movie or parts thereof to be consumed by the user via a video player.”

With respect to obviousness-type rejections, the Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to modify a reference or to combine the teachings of multiple references. *Id.* Second, the prior art can be modified or combined only so long as there is a reason of expectation of success. *In re Merck & Company Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference or combined prior art references must teach or suggest all of the claims limitations. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). *Emphasis added.*

In addition, in performing the obviousness inquiry under 35 U.S.C. §103, the Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990) reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). The best defense against hindsight-based obviousness is to stringently require a showing of a teaching or motivation to combine the prior art references and that all of the claimed limitations are taught or suggested in the prior art references. *Ecolochem, Inc. v. Southern California Edison Company*, 226 F.3d 1361, 1371, 56 U.S.P.Q.2d 1065, 1073 (Fed. Cir. 2000). *Emphasis added.* Furthermore, the mere fact that knowledge *may* have been within the scale of an ordinary artisan does not in and of itself make it so, absent some clear and convincing evidence of such knowledge. *Smith Industries Medical Systems, Inc. v. VitalSigns, Inc.*, 183 F.3d 1347, 1356, 51 U.S.P.Q.2d 1415, 1421 (Fed. Cir. 1999).

It is believed that neither the Gioscia PCT Patent nor the Gibson patent, alone or in combination, teach or suggest all of the claimed limitations. In addition, there is no objective

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teaching in the prior art or some general knowledge which would teach, suggests, or motivate one to modify the references as need to produce the claimed invention.

In light of the above remarks, it is believed that independent claim 1, and all claims depending therefrom, are patentably distinguishable over the prior art of record. Notice to that effect is respectfully requested.

Independent claims 15 and 29 have been amended to include a similar limitation to that discussed with reference to independent claim 1. Specifically, independent claims 15 and 29 each include "at least one entertainment media packet which includes audio and visual media". For the reasons stated with respect to independent claim 1, it is believed that independent claims 15 and 29, and claims depending therefrom, are also patentably distinguishable over the prior art of record. Notice to that effect is respectfully requested.

On page 13 of the Office Action, the Examiner rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over the Gioscia PCT Patent and Gibson. Claim 8 is a dependant claim depending from independent claim 1. As previously discussed, it is believed that independent claim 1 is in condition for allowance. Therefore, it is also believed that claim 8 is in condition for allowance.

On page 14 of the Office Action, the Examiner rejected claim 3 under U.S.C. §103(a) as being unpatentable over the Gioscia PCT Patent and Gibson, and further in view of Gioscia et al. (US 6,407,750). Claim 3 is a dependant claim depending from independent claim 1. As previously discussed, it is believed that independent claim 1 is in condition for allowance. Therefore, it is also believed that claim 3 is in condition for allowance.

No new matter has been added to any amended claims, and therefore, no new search is necessary because of this Amendment.

Newly Submitted Claims

With this Amendment, claims 30-37 are newly presented, of which claims 30 and 34 are independent claims. It is believed that these newly submitted claims are patentably distinguishable over the prior art and in proper form for allowance.

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CONCLUSION

The Examiner is invited to contact the Applicant's representative at the below-listed telephone number to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Michael R. Binzak at Telephone No. (612) 573-0427, Facsimile No. (612) 573-2005 or Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30th day of June, 2003.

By: Michael Binzak
Name: Michael R. Binzak